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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,045	02/01/2001	Michael Harwell	1916. ADH	3155

7590

10/27/2004

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EXAMINER
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MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/775,045	Applicant(s) HARWELL ET AL.	
	Examiner Margaret G. Moore	Art Unit 1712	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 August 2004.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 to 6, 21 to 26 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1 to 6, 21 to 26 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Upon reconsideration and in view of applicants' remarks, the Examiner has withdrawn the rejection over Maleeny et al. She agrees that the excerpt relied upon in the rejection, the disclosure on the top of column 8, appears to be out of context and inappropriate. A complete reading of the teachings in Maleeny et al. does not lead one to believe that the compositions therein are hot melt adhesives. For instance the top of column 8 refers to the composition as waterborne, but never is the polymer therein waterborne. Also the only other use of the word adhesive, adhere or adhesion in the entire patent is found on column 7, line 60, which teaches the optional addition of adhesion promoters. The Examiner notes that Maleeny et al. '311 contains this same paragraph and it, too, seems out of context.

2. Claim 4 contains the trademark/trade name Quest Fragrance Q-26257. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the fragrance and, accordingly, the identification/description is indefinite.

Applicants amendment does not overcome this rejection, as Quest Fragrance Q-26257 is a trade name. It is the name used to identify a source of goods rather than the goods themselves. One cannot determine what is in this fragrance and as such it is indefinite.

3. Claims 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are indefinite. The recitation of "parts" without identifying the "type"

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of parts (for instance, parts by weight, parts by volume) renders this limitation indefinite.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 5, 6 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Krzysik.

This rejection relies on the rationale noted in the prior office action. Applicants' traversal is not persuasive. It is argued that Krzysik fails to disclose or suggest a composition comprising a hot melt adhesive, wherein the fragrance is part of the hot melt adhesive. This is simply contrary to what is taught in Krzysik. The bottom of column 8 clearly teaches a composition comprising a hot melt adhesive where in the adhesive is mixed with a fragrance. This anticipates the instant claims (note that the amount meets that in new claim 25).

Perhaps applicants are of the position that, since the composition in Krzysik is used as a sunscreen, this distinguishes the prior art from the claims; however, the Examiner does not agree. The instant claim is limited by the components therein and only require a thermoplastic hot melt adhesive and non-encapsulated scented material. Both components are found in the prior art composition and as such meet all of the claimed requirements. On the other hand, "thermoplastic hot melt adhesive" can be considered a functional limitation and one must consider if the prior art has the ability to function in the same manner. In this situation there is reason to believe that the prior art composition can function as a thermoplastic hot melt adhesive since it contains thermoplastic hot melt adhesive. The prior art composition need not function as an excellent or commercially successful thermoplastic hot melt adhesive to meet this functional limitation. Finally note the use of the term "comprising" which opens the claimed thermoplastic hot melt adhesive to the inclusion of any extra ingredients, including ones that could materially affect the base and novel characteristics of the composition. Thus, in the event that the composition in Krzysik absolutely had absolutely no hot melt adhesive properties whatsoever, the prior art anticipates the claims because they are open to

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the inclusion of any other material, including those that could take away from the hot melt adhesive properties of the hot melt adhesive therein. As such this rejection is maintained.

6. Claims 2 to 4 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krzysik.

Regarding claims 2 to 4, applicants' rely on the novelty of claim 1 in establishing unobviousness. As noted above, claim 1 remains anticipated by Krzysik and as such these rejections are maintained.

With regard to claim 26, given the breadth of the term "about, the upper limit of "about .15 parts" overlaps with the lower preferred limit of fragrance taught by Krzysik, .2 % by weight. In addition, the lower limit of .2 is only a preferred amount. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (i.e. does not require undue experimentation). Furthermore, a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. As such this limitation is rendered obvious.

7. Claims 1, 5, 6, 25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Cooke et al.

This rejection also relies on the rationale noted in the previous office action. Applicants' traversal of this rejection is not persuasive. It is argued that Cooke et al. fail to disclose or suggest a composition comprising a hot melt adhesive wherein the fragrance is part of the hot melt adhesive. The Examiner disagrees. The bottom of column 7 teaches hot melt pressure sensitive adhesives; column 9 details fragrances that are added thereto. Cooke et al. teach that the fragrance can be present in an amount such that the pressure sensitive adhesive properties are maintained (see column 10, lines 14 to 26, which meet the amount in claim 25). While other components

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may be present, they are not excluded from the claims. As such this rejection is maintained.

8. Claims 2 to 4, 21 to 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooke et al.

Regarding claims 2 to 4, applicants' rely on the novelty of claim 1 in establishing unobviousness. As noted above, claim 1 remains anticipated by Cooke et al. and as such these rejections are maintained.

With regard to claim 26, note that the column 10, line 24, teaches that the composition can include "up to" .5 wt% of fragrance, the lower limit of which embraces the claimed range. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (i.e. does not require undue experimentation). As such this limitation is rendered obvious.

With regard to claims 21 to 23, note for instance claim 13 of Cooke et al. which teaches these polymers. Since Cooke specifically teaches hot melt pressure sensitive adhesives and specifically teaches the polymers of claims 21 to 23, the skilled artisan would have been motivated to select hot melt pressure sensitive adhesives meeting the specific polymer types of claims 21 to 23, thereby rendering obvious these claims.

9. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooke et al. as applied to claims 1, 5, 6 and 21 to 23 above, and further in view of Colley et al.

Colley et al. is cited on the front page of Colley et al. In addition, the top of column 7 refers to four patents and the "references cited therein" as teaching operable adhesives. Colley et al. is also a "reference cited therein". As such this reference clearly can be considered analogous art and would be a reference that the skilled artisan would turn to in determining other operable adhesives. Column 6 in Colley et al. teaches using ethylene-vinyl acetate copolymers as an operable adhesive, along with other specific adhesives that are found in Cooke. Thus one having ordinary skill in the art would have recognized from the teachings of Colley et al. that ethylene-vinyl acetate

copolymers could be used with a reasonable expectation of success as an adhesive in the composition of Cooke et al. As such claim 24 is rendered obvious.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

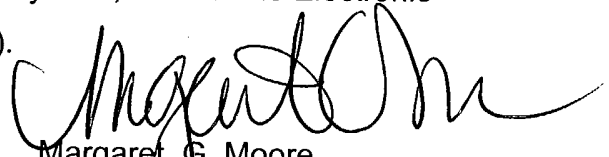
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
10/22/04